

Decision for dispute CAC-UDRP-103594

Case number	CAC-UDRP-103594
Time of filing	2021-02-25 09:24:08
Domain names	oneilldeutschland.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	O'Neill Brand S.à r.l
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Respondent

Name	Uwe Eisenhower
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

EU TM Registration No. 008499782 O'NEILL registered on May 17, 2010 for goods and services in various classes.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The O'NEILL trademark is a famous surf, ski and casual apparel brand that has developed its reputation internationally since being created in 1952. The Sisco Textiles N.V. is the exclusive legal owner of this trademark and part of the O'Neill group of companies. It grants an exclusive worldwide licence to use of this trademark to another member of the group, being the Complainant. Notably, it is also licencing use of copyright in the O'Neill logo to the Complainant.

Furthermore, the Complainant registered the domain name <oneill.com> in 1997 and uses that domain name for the group's business purposes.

The Respondent registered the disputed domain name on November 11, 2020. It did so without the authority or permission of the Complainant. The disputed domain name directs web-users to a website that clearly displays the O'Neill logo in the header and as a title on the homepage. The remainder of the website offers apparel for sale and lists the prices in euro. The content is written in German.

The Respondent has listed its name as "Uwe Eisenhower" and its address as being located in Germany.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

- 1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- 3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

The Complainant asserts it has a trademark registration consisting of the words O'NEILL in the European Union, which includes the nation of Germany. This registration predates the registration date of the disputed domain name by over a decade.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark O'NEILL. And, although not required, it has nevertheless done so in a jurisdiction in which the Respondent resides.

The next question is whether the disputed domain name is confusingly similar to the O'NEILL trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. And it also ignores the descriptive suffix "deutschland", which merely refers to the Respondent's location. Finally, it ignores the absence of the comma following "O" in O'Neill. Such punctuation does not form part of .com domain names. The Panel ignores these differences as they would be ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain

name, being the ONEILL element.

The disputed domain name is therefore confusingly similar to the ONEILL trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name according to information provided by the registrar for the disputed domain name is "UWE EISENHOWER". This name bears no resemblance to "ONEIL". Further, the website to which the disputed domain name resolves has does not have content which would indicate any right or legitimate interest in the disputed domain name. Such content actually indicates an absence of rights and bad faith use, as discussed below.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The Respondent has, without authority from the Complainant or Sisco Textiles N.V., used the latter's O'Neill logo and O'Neill trademark prominently in the banner of the website to which the disputed domain name directs and the heading on the homepage. The website also refers to the sale of clothing goods, uses the German language and offers such goods for sale in Euro. Such use provides an overall false and misleading impression that the Respondent has an official connection with the Complainant or Sisco Textiles N.V., which is clearly bad faith use of the recently registered disputed domain name (please see Bayerische Motoren Werke Aktiengesellschaft, Rolls-Royce Motor Cars Limited v. Mr David Redshaw, Auto Crowd, Auto Crowd Group / MEDIAGROUP24/ WhoisGuard Protected / WhoisGuard, Inc., WIPO Case No. D2015-0589). The Respondent is clearly misleading consumers into believing such a connection exists with the Complainant's and Sisco Textiles N.V.'s well known brand.

TRANSFER

Although it seems unusual that the Complainant is filed in the name of the Complainant, and not the trademark owner (being Sisco Textiles N.V.), the Panel is satisfied that as the Complainant is the worldwide exclusive licensee of the O'Neil trademark and copyright in the O'Neil logo. In such circumstances it is clear under the Policy that a transfer can be made to either the trademark owner or the exclusive licensee. Therefore the Panel directs transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ONEILLDEUTSCHLAND.COM**: Transferred

PANELLISTS

Name	Mr Andrew Norman Sykes
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DATE OF PANEL DECISION 2021-04-05

Publish the Decision
